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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Salvatore Cirillo

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EXAMINER

HAYES, BRET C

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/775,076	Applicant(s) CIRILLO, SALVATORE	
	Examiner Bret Hayes	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8,10-13,15,16,18,19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 1,4,8,10,15,16,18,19 and 23-27 is/are rejected.
- 7) ☒ Claim(s) 3 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>14 MAR 05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Response, filed 28 APR 06, with respect to claim 3 have been fully considered and are persuasive. The rejection of claims 3 & 11 has been withdrawn.

However, Applicant's arguments filed 28 APR 06, with respect to the remaining claims have been fully considered but they are not persuasive.

2. Applicant alleges that "bag 32 cannot be said to define a seamless enclosure with an open and a closed end," because the closed end would be of a folded construction. From "*The American Heritage® Dictionary of the English Language, Fourth Edition. Copyright © 2000 by Houghton Mifflin Company. Published by Houghton Mifflin Company. All rights reserved.*", the term 'seamless' is defined as having no seams, and a seam is defined as:

1.
 - a. A line of junction formed by sewing together two pieces of material along their margins.
 - b. A similar line, ridge, or groove made by fitting, joining, or lapping together two sections along their edges.
 - c. A suture.
 - d. A scar.
2. A line across a surface, as a crack, fissure, or wrinkle.
3. A thin layer or stratum, as of coal or rock.

Since Applicant has not given any special meaning to the term 'seamless' in the specification, the normal definition must be used. It would appear then, that the bag 32 qualifies as being seamless just as much as the claimed invention, because, while a folded construction may be considered a wrinkle, from the definition above, for example, a similar line, ridge, or groove will

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be made by fitting, joining, or lapping together two sections along their edges as disclosed and shown in Figs. 8a & 8b, for example. Examiner cannot determine how these lines, ridges or grooves differ from the prior art as far as the definition of seamless is concerned. Or, perhaps, even more simply where the fabric meets at the edges there would a crack or fissure, which is also considered to be a 'seam' by definition. The point of all this is that there is nothing in the specification to define the term any differently than as broadest and most reasonable.

3. Further, Applicant alleges that the examiner improperly reads the reference, stating "In addition, a skilled reader would clearly not be led, either by the teaching of Barker or Donovan, to believe that the top or bottom flap of the container 34 in Barker constitutes an attachment system for maintaining the first panels in a deployed configuration. With respect the Examiner is not entitled to read the prior art differently than one skilled in the art would. The Container 34 is clearly disclosed as being, for example, a cardboard box. The flaps of cardboard boxes are usually free to move between a closed and an open configuration, and therefore would not, absent of more specific teaching to this effect constitute an attachment system as claimed."

Examiner asserts that Applicant is not entitled to read the claim language nor read any limitation into the claim any differently than one skilled in the art. In that sense, there is nothing special disclosed about the 'attachment system' other than its function of 'maintaining the first panels in a deployed configuration'. Simply calling something an attachment system does not require the system attach anything together nor be attached to anything. Examiner has provided such an 'attachment system', the flaps of any box 'maintaining the first panels in a deployed configuration' when they are placed into a closed configuration (sometimes even on top of one another), Applicant's arguments notwithstanding.

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4. In response to the Applicant's argument that the material disclosed by Barker is incapable of expanding, Applicant admits the material's flexibility, as at page 2, line 3 of the arguments, for example. This flexibility, while perhaps not *as* expandable as the claimed invention, is certainly sufficient to expand, and, thus, is sufficient suggestion or motivation to make the modification as set forth previously.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 8, 10, 15, 18, 19 and 23 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker as previously cited in view of US Patent No. 4,574,105 to Donovan (previously cited).

7. Re – claims 1, 23, 26 and 27, Barker discloses the claimed invention including a container comprising: a seamless enclosure 32 made of walls defining a first open end, best seen in Fig. 1, for example, and a first closed end*, the seamless enclosure being collapsible**; an outer casing 34 having a plurality of first and second panels, as in opposing sides of the container itself, defining a second enclosure for snugly receiving the seamless enclosure 32, the first and second panels being rigid, the first panels being hingedly connected*** to the second panels such that the first panels are movable** between a first deployed configuration, where the first panels define a second open end corresponding to the first open end, to a second folded configuration, where the first panels at least partially close the second open end, thereby

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reducing a height of the outer casing 34; and a first attachment system**** on the outer casing

34. Regarding the functional “whereby” clause, as long as the device as disclosed by Barker is capable of performing the intended use, it anticipates the claim. In this case, the container of Barker is capable of ‘[being] folded for storage by collapsing the seamless enclosure and moving the first panels of the outer casing in the second folded configuration’. The first and second configuration being a container as shown in the Figures and the same container ‘flattened’ and, thus, folded.

*Barker discloses an expandable bag 32, which ‘bag’ is generally understood to have a first open end and a first closed end – such as the grocery bags I saw the last time I was at the grocery store leastways. Further, the definition of the term ‘bag’ would be understood to include an open “top” and a closed “bottom”, for example.

**It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. In this case, any “-ble” type terms, i.e., collapsible, are intended to be covered by the above. Barker’s device need only be able to so perform, which it is.

***Most shipping containers of this type have panels, which are hingedly connected in order to fold the containers for shipment in bulk (flat), for example, and to unfold the containers for placing items to be shipped inside.

****In this case, the first attachment system is the top or bottom flaps of the container.

Barker discloses the claimed invention except for the walls being formed by a plurality of independent interleaved plies of material, the material and number of plies being selected to

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contain fragments projected by the explosion. Donovan teaches walls 10 being formed by a plurality of independent interleaved plies of material 12 and 16, the material and number of plies being selected to contain fragments projected by the explosion in the same field of endeavor for the purpose of containing fragments projected by an explosion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker to include the walls as taught by Donovan in order to contain fragments of an explosion.

Specifically regarding claim 27, the walls of the enclosure (a bag) would inherently have a constant thickness. One would need motivation to alter what has become the norm in bags.

8. Re – claim 4, Barker in view of Donovan discloses the claimed invention. Barker further discloses the material being “made from a suitable fragment resistant fabric such a woven ballistic cloth,” except for the material being composed of an extended chain polyethylene fabric. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute such a fabric, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

9. Re – claim 8, Barker in view of Donovan discloses the claimed invention except for the first and second panels being composed of a rigid foam core sandwiched between two sheets of polyethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first and second panels be composed of a rigid foam core sandwiched between two sheets of polyethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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10. Re – claim 10, Barker in view of Donovan discloses the claimed invention. Barker further discloses the outer casing and foldable bag having a prismatic shape, in that “prismatic” in this sense is taken to mean opposing bases or ends having the same shape, that shape being a parallelogram and a parallelogram being a four-sided plane figure with opposite sides parallel.

11. Alternatively, re – claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement a prismatic shape, since there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23. See US Patent No. 6,196,107 B1 to Hoffman et al., FIG. 18, for an example of an alternatively shaped containment vessel.

12. Re – claim 15, in view of claims 1, 10 and 23 above, Barker in view of Donovan discloses the claimed invention.

13. Re – claim 18, in view of claims 1 and 23 above, Barker in view of Donovan discloses the claimed invention.

14. Re – claim 19, in view of claims 1, 4 and 23 above, Barker in view of Donovan discloses the claimed invention.

15. Re – claim 24, Barker in view of Donovan discloses the claimed invention. Donovan further teaches the interleaved plies of material extending in alternating orientations, orthogonal to each other. Because Donovan shows the plies one on top of the other, as in Figs. 1 and 2, it would be inherent that the plies 1) extend, and 2) in alternating orientations, orthogonal to each other, since one ply on top of another is “alternating orthogonally orientated” 90 degrees out of phase with the adjacent preceding ply.

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16. Re – claim 25, Donovan further teaches the materials being in the form of elongated flexible woven strips. Donovan discloses its use in curtains, which are inherently elongated and the material so used would be in flexible woven strips.

Allowable Subject Matter

17. Claims 21 and 22 are allowed.

18. Claims 3 & 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902 or email address bret.hayes@uspto.gov. The examiner can

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normally be reached Monday through Thursday from 5:30 am to 4:00 pm, Eastern Standard Time.

The Central FAX Number is **571-273-8300**.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (571) 272 – 6873.

Bret Hayes

29-Jun-06


MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER